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09/913280 #5

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of

Karl J. ZEITSCH

Serial No. 09/913,280
(PCT/ZA00/00024)

Box PCT
Attention: Office of
PCT Legal Affairs

Filed August 13, 2001

PROCESS FOR THE MANUFACTURE OF FURFURAL

RENEWED SUBMISSION UNDER 37 CFR 1.42

Assistant Commissioner for Patents

Washington, D.C. 20231

Sir:

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29 MAR 2002
Legal Staff
International Division

In response to the accompanying Decision on Papers Under 37 CFR 1.42 dated January 3, 2002, we enclose herewith the executed declaration executed by the executor of the deceased inventor Karl J. Zeitsch estate, Mrs. Hanna Tepohl.

It is respectfully requested that status under 37 CFR 1.42 be granted

Also enclosed is an updated Application Data Sheet which provides the particulars of the legal representative.

Respectfully submitted,

YOUNG & THOMPSON

By

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March 4, 2002
Ref. 251713

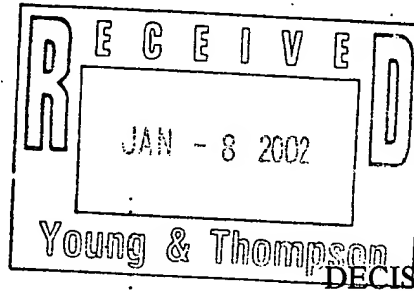
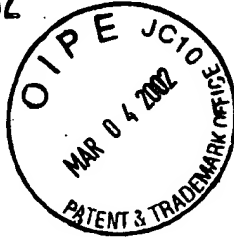


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JAN 08 2002

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M-PTB-Decl.

In re Application of
ZEITSCH, Karl J.
Application No.: 09/913,280
PCT No.: PCT/ZA00/00024
Int. Filing Date: 11 February 2000
Priority Date: 11 February 1999
Attorney's Docket No.: 251713
For: PROCESS FOR THE MANUFACTURE
OF FURFURAL

DECISION ON

PAPERS

UNDER 37 CFR 1.42

This is a decision on the declaration submitted on 27 November 2001. A review of the Declaration reveals an indication that the sole inventor Karl J. Zeitsch is deceased. Applicant's submission taken together with the indication that sole inventor Zeitsch is deceased has been treated as a request for status under 37 CFR 1.42.

BACKGROUND

On 11 February 2000, applicant filed international application PCT/ZA00/00024, which claimed a priority date of 11 February 1999. A copy of the international application was communicated to the United States Patent and Trademark Office (USPTO) from the International Bureau on 17 August 2000.

On 13 August 2001, applicant filed a submission for entry into the national stage in the United States which was accompanied by, *inter alia*, the U.S. Basic National Fee.

On 11 October 2001, the Office mailed a "Notification of Missing Requirements Under 35 U.S.C. 371 In the United States Designated/Elected Office," (Form PCT/DO/EO/905) noting, *inter alia*, that an oath or declaration of the inventors complying with 37 CFR 1.497(a)-(b) was required.

On 27 November 2001, applicant filed a declaration executed by Mr. Philipp D.P. Steiner, who was "authorized by Hanna TEPOHL, the executor of deceased inventor Karl J. Zeitsch, to execute the declaration."

DISCUSSION

Under 35 U.S.C. §117, legal representatives of deceased inventors may make application for patent upon compliance with the requirements and on the same terms and conditions

applicable to the inventor. The "legal representative (executor, administrator, etc.) of the deceased inventor may make the necessary oath or declaration, and apply for and obtain the patent." 37 CFR 1.42.

In this case, applicant has provided a power of attorney stating that the executor is appointing a "legal representative" to act on behalf of the executor in matters regarding German Patent Application No. 199 05 655.2. The declaration of inventorship must be signed by the legal representative of the deceased inventor, in this case the executor, Mrs. Tepohl. It may not be signed by another appointed as agent for the legal representative on behalf of the legal representative. See MPEP 605.04(a). In the present case, Mr. Philipp D.P. Steiner is not the legal representative of the deceased inventor, but rather an agent for the heir. As such, execution of the declaration by Mr. Philipp D.P. Steiner is improper. The declaration must be executed by the executor of the estate, Mrs. Hanna Tepohl.

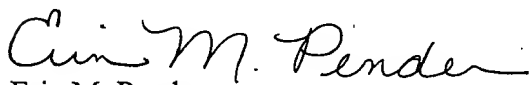
Further, under 37 CFR 1.497(b)(2), the declaration must include the residence, mailing address and citizenship of the person(s) signing on behalf of the deceased inventor and the information that the inventor would be required to state. It is noted that under the name of Karl J. Zeitsch, the residence is listed as Kwa Zulu Natal, South Africa, the postal address is Durban and the citizenship is listed as South Africa. However, the PCT application lists Mr. Zeitsch as a citizen of Germany with a residence and postal address in Köln (Cologne). Again, the declaration must provide the information for the legal representative (executor) and for the deceased inventor.


CONCLUSION

For the above reasons, the request for status under 37 CFR 1.42 is **REFUSED**.

Applicant is required to submit a declaration in compliance with 37 CFR 1.497 and 1.42 within a time period of **TWO (2) MONTHS** from the mail date of this Decision. **THIS PERIOD FOR RESPONSE MAY BE EXTENDED UNDER 37 CFR 1.136(a). FAILURE TO PROPERLY RESPOND WILL RESULT IN ABANDONMENT.** Any request for reconsideration of this decision should include a cover letter entitled "Renewed Submission Under 37 CFR 1.42."

Please direct any further correspondence with respect to this matter to the Commissioner of Patents and Trademarks, Box PCT, Washington, D.C. 20231, and address the contents of the letter to the attention of the Office of PCT Legal Administration.


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